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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,449

06/23/2003

Masao Watanabe

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5514 7590 02/09/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

VO, QUANG N

ART UNIT

PAPER NUMBER

2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/600,449

Applicant(s)

WATANABE, MASAO

Examiner

Quang N. Vo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/03;10/16/03;11/29/06</u>                                 | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34, 42, 43, 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims have subject matters "wherein the selecting means selects the first mode when sheets having images formed thereon beforehand by the color image forming means or the black-and-white image forming means are mixed without passing through an image forming position, and selects the second mode when the sheets are mixed after passing through the image forming position", these subject matters are not described in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-40, 42-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshihiro (Pub. No.: 2000-222148), Kiyoshi (Pub. No.: 2002-086852) and Nimura et al. (Nimura) (Pub. No.: US 20010021036).

With regard to claim 34, Toshihiro discloses a system in which in a case where a color page and a black-and-white page are to be formed on a single sheet, an image for the color page is formed by a color printer and an image for the remaining page is formed by a black-and-white printer (paragraph 0008).

Kiyoshi discloses a technique in which in a case where a color page and a black-and-white page are to be formed on a single sheet, images for all the pages are formed by a color printer (paragraph 0020).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro to include where a color page and a black-and-white page are to be formed on a single sheet, images for all the pages are formed by a color printer as taught by Kiyoshi. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro by the teaching of Kiyoshi to achieve selectable implementation to form an image for the color page using a color printer and an image for the remaining page using a black-and-white printer, or to form images for all the pages using the color printer.

Toshihiro and Kiyoshi differ from claim 34, in that they do not teach wherein the selecting means selects the first mode when sheets having mages formed thereon beforehand by the color image forming means or the black-and-

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white image forming means are mixed without passing through an image forming position, and selects the second mode when the sheets are mixed after passing through the image forming position.

Nimura discloses a control method of controlling an image forming apparatus comprising forming images on blank sheet by image forming section and if an image formed it feeds in a manner bypassing image formation (paragraph 0009).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro and Kiyoshi to include a control method of controlling an image forming apparatus comprising forming images on blank sheet by image forming section and if an image formed it feeds in a manner bypassing image formation as taught by Nimura. . It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro and Kiyoshi by the teaching of Nimura to save time and labor (paragraph 0006).

With regard to claim 35, Toshihiro discloses further comprising:

a merging path where sheets on which images are to be formed by the color image forming means or sheets on which images have been formed by the color image forming means, and sheets on which images are to be formed by the black- and-white image forming means or sheets on which images have been formed by the black-and-white image forming means merge (paragraph 0006); and sheet feeding means for feeding a sheet having an image formed thereon beforehand by the color image forming means or a sheet having an image

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formed thereon beforehand by the black-and-white image forming means to the merging path, wherein the selecting means selects one of the first mode and the second mode depending on the type of the sheet feeding means used (paragraph 0018).

With regard to claim 36, Toshihiro discloses wherein the merging path is located at a position where the sheets on which images are to be formed by the color image forming means and the sheets on which images are to be formed by the black-and-white image forming means merge after completion of image formation, and the selecting means selects the first mode when the sheet feeding means that feeds a sheet to the merging path is used (paragraphs 0018 and 0036).

With regard to claim 37, Toshihiro discloses wherein the merging path is located at a position where the sheets on which images are to be formed by the color image forming means or the sheets on which images are~ to be formed by the black-and-white image forming means merge before completion of image formation, and the selecting means selects the second mode when the sheet feeding means that feeds a sheet to the merging path is used (paragraphs 0018 and 0036).

With regard to claim 38, Toshihiro discloses wherein the job in which both a color page and a black-and- white page exist is input from a computer connected to the image formation system (paragraph 0034).

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With regard to claim 39, Toshihiro discloses wherein the job in which both a color page and a black-and-white page exist is input from a scanner connected to the image formation system (paragraph 0078).

With regard to claim 40, Toshihiro discloses wherein the color image formation apparatus and the black- and-white image formation apparatus receive the same job (paragraph 0001).

With regard to claim 42, the subject matter is similar to claim 34. Therefore, the rejection on claim 42 is the same as the rejection on claim 34.

With regard to claim 43, the subject matter is similar to claim 34. Therefore, the rejection on claim 43 is the same as the rejection on claim 34 (also see paragraph 0035).

With regard to claim 44, the subject matter is similar to claim 35. Therefore, the rejection on claim 44 is the same as the rejection on claim 35. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 45, the subject matter is similar to claim 36. Therefore, the rejection on claim 45 is the same as the rejection on claim 36. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 46, Toshihiro discloses wherein the sheet feeding means is an inserter or a collator (paragraph 0044).

With regard to claim 47, Toshihiro discloses wherein the sheet feeding means is provided in the black-and-white image formation apparatus, and is configured to feed the sheet having an image formed thereon beforehand by the color image forming means, the color image formation apparatus further comprises determining means for determining whether a received page is a color page or a black-and-white page based on the image information received by the receiving means, and it is determined whether the received page is black-and-white or color according to the determination result of the determining means (paragraphs 0018, 0022, 0023).

With regard to claim 48, the subject matter is similar to claim 34. Therefore, the rejection on claim 48 is the same as the rejection on claim 34. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 49, the subject matter is similar to claim 35. Therefore, the rejection on claim 49 is the same as the rejection on claim 35. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 50, Toshihiro discloses wherein the sheet feeder is a hand feed unit (paragraph 0036).

With regard to claim 51, the subject matter is similar to claim 44. Therefore, the rejection on claim 51 is the same as the rejection on claim 44. It



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would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 52, the subject matter is similar to claim 48. Therefore, the rejection on claim 52 is the same as the rejection on claim 48. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 53, the subject matter is similar to claim 34. Therefore, the rejection on claim 53 is the same as the rejection on claim 34.

With regard to claim 54, the subject matter is similar to claim 35. Therefore, the rejection on claim 54 is the same as the rejection on claim 35 (also see paragraph 0055).

With regard to claim 55, the subject matter is similar to claim 45. Therefore, the rejection on claim 55 is the same as the rejection on claim 45 (see also Toshihiro's paragraph 0055).

With regard to claim 56, Toshihiro discloses wherein the sheet feeding means is an inserter or a collator (paragraph 0044).

With regard to claim 57, the subject matter is similar to claim 51. Therefore, the rejection on claim 57 is the same as the rejection on claim 51. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

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With regard to claim 58, the subject matter is similar to claim 52. Therefore, the rejection on claim 58 is the same as the rejection on claim 52. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 59, the subject matter is similar to claim 55. Therefore, the rejection on claim 59 is the same as the rejection on claim 55. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 60, the subject matter is similar to claim 50. Therefore, the rejection on claim 60 is the same as the rejection on claim 50. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 61, the subject matter is similar to claim 47. Therefore, the rejection on claim 61 is the same as the rejection on claim 47. It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve selectable implementation and it is a common to associate related functions in advance.

With regard to claim 62, the subject matter is similar to claim 52. Therefore, the rejection on claim 62 is the same as the rejection on claim 52. It would have been obvious to one of ordinary skill in the art at the time of the

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invention to achieve selectable implementation and it is a common to associate related functions in advance.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toshihiro, Kiyoshi and Nimura, as applied to claims 34-40 above, and further in view of Hiroyuki (Pub. No.: 2000-112688).

With regard to claim 41, Toshihiro, Kiyoshi and Nimura differ from claim 41, in that he do not teach a case where both a color page and black-and- white page are imposed on a single sheet in saddle-stitch book binding.

Hiroyuki discloses a case where both a color page and black-and- white page are imposed on a single sheet in saddle-stitch book binding (paragraph 0047).


Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro and Kiyoshi and Nimura to include a case where both a color page and black-and- white page are imposed on a single sheet in saddle-stitch book binding as taught by Hiroyuki. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Toshihiro, Kiyoshi and Nimura by the teaching of Hiroyuki to achieve selectable implementation and it is a common to associate related functions in advance to save time and labor (paragraph 0004).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Vo whose telephone number is 5712701121. The examiner can normally be reached on 7:30AM-5:00PM Monday-Friday.

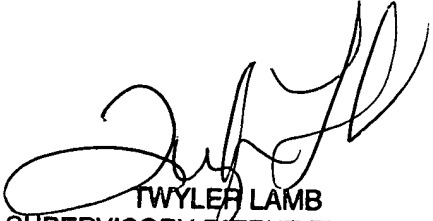
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on 5712727406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Quang N. Vo  
Patent Examiner

1/22/07

  
TWYLER LAMB  
SUPERVISORY PATENT EXAMINER